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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,733	08/30/2000	Alejandro M. Pilato	11725-46001	2432

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EXAMINER

FULTS, RICHARD C

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,733

Applicant(s)

PILATO, ALEJANDRO M.

Examiner

Richard Fults

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My

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is responsive to Applicant's amendment and request for reconsideration (Paper #9) dated 1/15/2004, which amended claims 1, 112-113, and 136-139. Accordingly claims 1-139 are presented for examination on their merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over ATKINS (US 5,644,727 A) in view of JONES et al (US 6,021,397) (hereinafter Jones).

As to claims 1-139 Atkins explicitly discloses (see columns 1-80) the computerized provision of financial services and functions, both directly and through advice and recommendations and guidelines of management and investment objectives, to a plurality of clients regarding both the active and recommended management of a wide variety of credit, debt, treasury, and assets and liabilities, pension funds, portfolios, leases, trading, and indirectly through a plurality of investment asset classes commodity prices and real estate. Included in the provision of these financial functions are both the enabling of and action of normal communications of agent's actions and intent and advice, reporting of information and results, receiving of financial information, record keeping, creation of risk management information, all the

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computer information, network, and apparatus means needed to implement the financial functions, an apparatus for providing financial functions by an agent for each of a plurality of clients and a computer-readable medium storing instructions that when executed by one or more processors cause the one or more processors to perform relating to a financial function of each client, demonstrating that more than one activity of the agent can be transparent to the client, receiving financial information at the agent, creating risk management information relating to the financial information, analyzing the risk management in the context of the financial information, determining an action based on the analysis, facilitating implementation of the action on behalf of the client, communicating with the client through a network one or more activities, a method for a client to outsource financial functions to an agent representing a plurality of clients providing and an apparatus for the means for providing financial information on one or more financial functions of the client to the agent, and an apparatus means for enabling the agent to determine an action based on the analysis of risk management information created from the financial information, and an apparatus means for allowing the agent to facilitate the implementation of the action, a method for an agent to provide financial functions to each of a plurality of clients regarding a financial function of a client from the plurality of clients, demonstrating to the client the potential transparency of activities of the agent, receiving financial information at the agent, analyzing risk management information created from and in the context of the financial information, facilitating implementation on behalf of an agent's action based on the analysis, and enabling the client to monitor through a network activities of the agent. Atkins does not explicitly teach an agent, or risk analysis, or transparency, or commodities.

Jones teaches (see columns 1-24) the **transparency** of financial activities to the client, the analysis of risk management information, the action based on that analysis, facilitating implementation of that action, and the communication of the financial activities to the client through a network. Jones also discloses the use of computer information, network, and apparatus needed to perform these transparency and risk related activities.

Because the teachings of both Atkins and Jones have been common practices in the provision of financial functions to a plurality of clients (individual, institutional, or corporate or otherwise) and the fact that the combination of the two would provide a more comprehensive and efficient set of financial services that would be common sense and be advantageous to the clients, it would have been obvious to one skilled in the art at the time of the invention to add teachings of Jones to those of Atkins, and to add the teachings of Atkins to those of Jones for the same reason.

While Atkins does not explicitly teach an agent, it would have been obvious to one skilled in the art at the time of the invention that an agent is simply a representative of the principal, and that it is common and advantageous for most principals to operate through either computers or other people, including employees, all of whom or which are agents representing the principal or the organization, and that the teachings of Atkins regarding risk preferences and risk aversion would obviously and commonly include risk analysis and the financial functions closely related to that process, and that while Atkins does not specifically teach the management of commodities or commodity price, it would have been obvious to one skilled in the art at the time of the invention to be aware of the fact that commodities are one class of assets that are commonly included in an investment portfolio, and that the words "institutional or corporate" are merely an intended use, and that an online brokerage firm who is acting as an agent for the user receives information through their computer and is monitored by the user through the internet network, and Atkins does teach the management of an investment portfolio.

3. Response to Applicant's Arguments

The amendment solved the 101 issue, so that rejection has been withdrawn. The two references in combination together with the obviousness statement establish a prima facie case of obviousness by teaching all the limitations, except for those of intended use. Just as a footnote, the applicant's claim that "page 8 of the application

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defines agent as a financial risk manager” is simply not true: it says no such thing. The amendments made (technology and intended use) do not alter the basic words of the claims originally examined, and the same references still apply.

The specifications and statements by the inventor at an interview describe this invention as essentially the outsourcing of many, if not all, common and well known financial functions of one company to an agent at another company. There is no difference in the functions performed or how they are performed, and the only difference is who performs them and the fact that they may be physically in another location requiring communication with using well known communication devices and methods and means, and that one company is paying another for their performance, and that common and well known performance information, criteria, and relationship relates to an outside agent rather than an internal agent (employee). These activities, steps, methods, and means are not novel, as evidenced by the functional descriptions and information contained within the references and obviousness statement. In addition the practice of outsourcing per se is old and well known, eg: janitorial functions, and in many companies the entire accounting function.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Fults whose telephone number is 703-305-5416. The examiner can normally be reached on weekdays from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough, can be reached on (703)-305-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



RCF

3/1/2004



JEFFREY PWU
PRIMARY EXAMINER